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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,494	11/13/2001	Kirk S. Giboney	10010363-1	2267

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AGILENT TECHNOLOGIES, INC.  
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Intellectual Property Department  
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EXAMINER
PETKOVSEK, DANIEL J

ART UNIT	PAPER NUMBER
2874	

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/007,494	<b>Applicant(s)</b> GIBONEY ET AL.	
	<b>Examiner</b> Daniel J Petkovsek	<b>Art Unit</b> 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 28, 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 19, 20, 22 and 25-33 is/are rejected.
- 7) ☒ Claim(s) 16-18, 21, 23, and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: <u>Bimfeer</u>                           |

### **DETAILED ACTION**

This office action is in response to the amendment filed July 28, 2003. In accordance with the amendment, claim 32 has been amended.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15, 19-20, 22, and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al. U.S.P. No. 6,450,704, and further in view of cited prior art of Applicant (Figure 1).

O'Connor et al. U.S.P. No. 6,450,704 teaches (Fig 1; Col 3 lines 1-23) an apparatus (and method of using same) which is an encasement for a connecting device to connect and interface an electro-optic signal device 18 to an optical cable comprising the following: base portion 29 encasing a plurality of optical devices in an optical array, an optically transparent substrate 11 connectable to base 29, substrate 11 being optically transparent and having a glass-like structure with desired optical properties (Col 3, lines 14-16), alignment pins 28 in alignment recesses 26 on the substrate 11 to create an alignment between the connector and the communications device relative to the substrate, the alignment pins 28 attached to the base 29 by an adhesive, or formed by molding or compression fit processes (Col 4, lines 27-30).

O'Connor et al. '704 does not explicitly teach that the lid portion is adapted to have at least a portion of the optical communications device 18 there between. In Figure 1 of the prior

art disclosed by Applicant, optical connector 10 connects an optical communications device 22 to an optical cable 16. A lid 12 having focusing elements 24 is affixed to the base portion 14, and the lid and base are adapted to receive at least a portion of the communications device 22 there between. Since O'Connor et al. '704 and Prior Art Fig. 1 are both from the same field of endeavor, the purpose of having the optical device 22 formed at least partially between the base 14 and lid 12 of Fig. 1 would have been recognized in the pertinent art of O'Connor et al. '704. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the connector of O'Connor et al. '704 by placing the optical device at least partially between the lid and base portion of '704, from the teaching of Fig. 1 for accurate alignment purposes.

O'Connor et al. '704 does not explicitly teach that the alignment member 28 is formed on the lid portion. The alignment member 28 is formed through the lid 11, aligning the optical device to the optical cable. The claim limitation of having the alignment member being formed on the lid portion does not overcome the prior art reference. The apparatus functions as a whole, integral apparatus. Claiming separate components that function identically during use as an integral apparatus does not overcome a relevant prior art reference having the same integral functionality (see *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965)). It is an obvious modification to form the alignment members on/through any part of the apparatus, since functionality is the same, aligning the optical device to the optical cable.

Regarding claim 2, the prior art Fig. 1 teaches a recess. Regarding claims 5, 7, 9, and 10, see lid portion of the alignment members, etc. of O'Connor et al. '704. Regarding claims 13-15, 19, 20, and 22, the methods are inherent from the device of O'Connor et al. '704. Regarding

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claims 3, 4, 6, 8, 11, 12, 28, 30, these slight changes in the formation of the alignment members are obvious modifications to a person having ordinary skill in the art, as these processes are well known ways to form different alignment members that connect/align optical devices. Although O'Connor '704 does not explicitly state that the alignment members are formed by specific steps/patterning, these limitations do not result in a structure that is readily discernible from the device disclosed in the by the prior art (O'Connor) and the structure being claimed is therefore completely met by the reference. Applicant is claiming structure, not method, and the USPTO bears a lesser burden when method-related limitations result in structure that cannot be readily discerned from structure not having such method-related limitations. (See MPEP 2113.)

Regarding claim 25, O'Connor '704 teaches (ABS) a plurality of devices in an array, and the devices are positioned there between the first 11 and second 29 substrates. Regarding claims 26, see column 4 lines 27-30. Regarding claims 27, 29, and 31, the prior art Figure 1 in combination with O'Connor et al. '704 positions the devices there between the substrates, as fully addressed above. Regarding claims 32-33, the lid and base collectively enclose a transducer mechanism, and see Fig. 2 for positioning.

### ***Allowable Subject Matter***

3. Claims 16-18, 21, and 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The relevant prior art does not teach or reasonably suggest the specific method steps, forms, and processes for which making the alignment members occur.

***Response to Arguments***

4. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive. Applicant traverses the 35 U.S.C. 103 (a) rejections to claim 1-15, 19, 20, 22, and 25-33 by stating that neither O'Connor et al. U.S.P. No. 6,450,704 or the prior art disclose the use of "at least one alignment member formed on the lid portion". Applicant states that the alignment members are placed through the lid portion, although they are not formed directly on the lid portion. This argument is not persuasive, since the apparatus works as an integral component, and separate sections of the lid portion, although connected differently, work together integrally to align the optical device to the optical cable. The argument is fully addressed above, in the 35 U.S.C. 103 (a) rejections to claim 1-15, 19, 20, 22, and 25-33 to O'Connor et al. '704.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J Petkovsek whose telephone number is (703) 305-6919. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (703) 308-4819. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9321.



Daniel Petkovsek  
October 16, 2003

